

REMARKS

This responds to the Office Action mailed on June 28, 2005.

Claims 1, 6, 10, 17, 20 and 23 are amended, no claims are canceled, and no claims are added; as a result, claims 1, 2, and 4-26 are now pending in this application.

About the Amendments

Applicant has amended claim 1 to include “wherein the processor to compare results from one of the executions of the plurality of instructions to results from another of the executions of the plurality of instructions.” Support for this amendment can be found in the Instant Application *inter alia* at Page 7, Lines 9-13.

Applicant has amended claim 6 to include “wherein the at least one execution is determined by analyzing a program for highly repeated executions.” Support for this amendment can be found in the Instant Application *inter alia* at Page 7, Lines 7 and 8.

Applicant has amended claim 10 to include “wherein the host system to compare a first result of replaying the at least one execution to a second result of replaying the at least one execution.” Support for this amendment can be found in the Instant Application *inter alia* at Page 11, Lines 18-21.

Applicant has amended claim 17 to include “wherein the at least one execution is determined by analyzing a program for highly repeated executions.” Support for this amendment can be found in the Instant Application *inter alia* at Page 7, Lines 7 and 8.

Applicant has amended claim 20 to include “comparing results of replaying the execution one time to results of replaying the execution other times.” Support for this amendment can be found in the Instant Application *inter alia* at Page 7, Lines 9-13.

Applicant has amended claim 23 to include “comparing results of replaying the execution one time to results of replaying the execution other times.” Support for this amendment can be found in the Instant Application *inter alia* at Page 7, Lines 9-13.

§103 Rejection of the Claims

Claims 1, 2, and 4-26 were rejected under 35 USC § 103(a) as being unpatentable over Deao et al. (U.S. 6,065,106; hereinafter referred to as Deao) in view of Kawasaki (U.S. 5,301,198).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Applicant submits that the Office Action has not established a *prima facie* case of obviousness because there is no suggestion to combine the cited references and because the cited combination does not teach or suggest all elements of each rejected claims.

No Suggestion to Combine Deao with Kawasaki

The Office Action posits several reasons for combining Deao and Kawasaki. For example, the Office Action asserts that one of ordinary skill in the art would combine Kawasaki with Deao “for the desirable purpose of achieving a highly efficient programmable controller with optimal debugging.” Office Action paragraph 4, pages 2-3. The Office Action also asserts, “It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system as taught by Deao et al. to have the user modify the replay handler in order to extract desired information.” Office Action paragraph 17, page 7. Although highly efficient programmable controllers and various replay information may be desirable, such a desire is not

enough to support the combination under 35 USC §103. The Office Action does not point to a single passage any reference that teaches or suggests the combination. Neither Kawasaki nor Deao identify benefits of repeatedly executing a plurality of instructions, much less adding such a feature to Deao's invention. Therefore, Applicant submits that the Office Action has improperly combined Deao with Kawasaki.

The Cited Combination does not Teach or Suggest all the Elements

Discussion of Claim 1

Claim 1 recites “wherein the processor to compare results from one of the executions of the plurality of instructions to results from another of the executions of the plurality of instructions.” Applicant submits that Deao does not teach repeatedly executing a plurality of instructions. Applicant also submits that although Kawasaki does teach “debugging on a loop basis,” Kawasaki does not teach or suggest the claimed comparing “results from one of the executions of the plurality of instructions to results from another of the executions of the plurality of instructions.” See Kawasaki at Column 3, Lines 41 and 42. For at least this reason, Applicant submits that the combination of Deao and Kawasaki does not teach or suggest each and every element of claim 1.

Discussion of Claims 10, 20, and 23

Claim 10 recites “wherein the host system to compare a first result of replaying the at least one execution to a second result of replaying the at least one execution.” Claim 20 recites “comparing results of replaying the execution one time to results of replaying the execution other times.” Claim 23 recites “comparing results of replaying the execution one time to results of replaying the execution other times.” For reasons similar to those noted in the discussion of claim 1, Applicant submits that the combination of Deao and Kawasaki does not teach or suggest each and every element of claims 10, 20, or 23.

Discussion of Claims 2, 4, 5, 11-16, 21, 22, and 24-26

Claims 2, 4, 5, 11-16, 21, 22, and 24-26 each depend, directly or indirectly, on one of claims 1, 10, 20, or 23. For at least the reason noted above, Applicant submits that the

combination of Deao and Kawasaki does not teach or suggest each and every element of claims 2, 4, 5, 11-16, 21, 22, and 24-26.

Discussion of Claim 6

Claim 6 recites “wherein the execution is determined by analyzing a program for highly repeated executions.” Applicant submits that the combination of Deao and Kawasaki does not teach or suggests the cited claim feature. For at least this reason, Applicant submits that the combination of Deao and Kawasaki does not teach or suggest each and every element of claim 6.

Discussion of Claim 17

Claim 17 recites “wherein the at least one execution is determined by analyzing a program for highly repeated executions.” Applicant submits that the combination of Deao and Kawasaki does not teach or suggest the cited claim feature. For at least this reason, Applicant submits that the combination of Deao and Kawasaki does not teach or suggest each and every element of claim 17.

Discussion of Claims 7-9, 18, and 19

Claims 7-9, 18 and 19 each depend, directly or indirectly, on one of claims 6 or 17. For at least the reason noted in the discussion of claim 1, Applicant submits that the combination of Deao and Kawasaki does not teach or suggest each and every element of claims 7-9, 18 and 19.

Reservation of Rights

Applicant does not admit that documents cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such documents should not be construed as admissions that the documents are prior art. Applicant also reserves the right to pursue canceled and originally filed claims in a continuation application. Furthermore, Applicant does not acquiesce to any of the Examiner’s assertions about the claims or the cited documents and reserves the right to argue these assertions in the future.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Andrew DeLizio at (281)-213-8980, or Applicant's below-named representative to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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Date Oct. 24, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of October, 2005.

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